

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

REMARKS

The current patent application has been reviewed in light of the Office Action, dated August 23, 2006, (hereinafter "the office action") in which: the specification stands objected to based on informalities; claims 1-11 stand objected to based on informalities; claims 1-11 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement; claim 11 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite; claims 1-7 stand rejected under 35 U.S.C. §102(e) as being anticipated by Kosoburd et al., U.S. Patent Application Serial No.: 09/800,415 (hereinafter Kosoburd); claims 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kosoburd in view of Ju et al., U.S. Patent Application No.: 6,064,637 (hereinafter Ju); and claims 9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kosoburd in view of Alon, U.S. Patent Application No.: 5,729,512 (hereinafter Alon). Reconsideration of the above-referenced patent application in light of the foregoing amendments and following remarks is respectfully requested.

Claims 1-42 are currently pending. Claims 1-7 and 10-11 are amended. New claims 12-42 are added. No claims have been cancelled. The foregoing amendments are made without prejudice or disclaimer. It is noted that the foregoing amendments to the claims do not narrow claim scope. Rather, many of the foregoing amendments broaden claim scope. Therefore, no prosecution history estoppel results from the foregoing amendments to the claims.

Priority

In the office action, the Examiner acknowledged Assignee's claim for priority based on Taiwanese Patent Application Serial No. 92127383. The Examiner also noted that Assignee had not

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

submitted a certified copy of TW 92127383. A certified copy of TW 92127383 has been ordered and Assignee will submit it to the Examiner for approval after it is received.

Substitute Specification

In the office action, the Examiner objected to the specification and requested that the Assignee clarify the use of the terms light source and light beam. It is, therefore, noted that a substitute specification in accordance with 37 CFR §1.125 is provided with this amendment. This is to correct minor and inadvertent typographical errors and to amend the specification to address the Examiner's request. No new matter is submitted in the substitute specification. As required by 37 CFR §1.125(c), a marked-up copy and a clean copy of the substitute specification are provided. Therefore, Assignee requests that the Examiner withdraw the objection to the specification and enter this substitute specification.. It is noted that the foregoing amendments to the specification are not intended to narrow claim scope in any way.

Claim Objections

In the office action, the Examiner objected to claims 1-11 because of a number of informalities. The Examiner specifically requested corrections to various claims. Assignee has amended these claims to address the Examiner's request. It is therefore requested the Examiner withdraw his claim objections. Likewise, other amendments to the claims have been made to address other informalities not specifically raised by the Examiner. It is noted that none of the foregoing amendments, however, narrow claim scope. In fact, in many instances, claim scope is broadened as a result of the foregoing amendments. Therefore, no prosecution history estoppel results from these changes to the claims.

Claim Rejections – 35 U.S.C. §112 ¶ 1

In the office action, the Examiner rejected claims 1-11 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Assignee respectfully traverses the Examiner's

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

rejection for at least the reasons explained herein and respectfully requests that the Examiner withdraw this rejection of the claims on this ground.

Assignee respectfully submits that the Examiner misunderstood the description in the current specification. Assignee respectfully submits that there is sufficient direction provided in the specification of the current application such that one of ordinary skill in the art would be able to practice the claimed subject matter without undue experimentation. In particular, the function of distancing light beams, the technical aspect highlighted by the Examiner, is described with respect to several embodiments of the current application. It is suggested that the Examiner may have overlooked the fact that more than one embodiment is described in the specification providing this capability. Therefore, Assignee submits that this aspect of the claimed subject matter is well described in the current application.

As discussed above, the current application describes several embodiments that are capable of carrying out the function of distancing light beams. For example, in one embodiment, distancing light beams is accomplished by a light-switching module, as described in paragraphs 15 and 42 of the current application, also as depicted in Figures 4, 6a and 6b. Further, in another embodiment, a wave-distance-dividing module to distance light beams is described, more specifically, in paragraphs 8, 10, 29, 30, 41 and 42, and an embodiment is depicted in Figure 8. Assignee, therefore, submits that based on the current specification, a person of ordinary skill in the art is capable of making and using a device within the scope of the presently claimed subject matter.

The Assignee disagrees with the position stated by the Examiner that: "....the wave-distance-dividing module is to divide the beamThis is crucial to the invention as a whole...." Rather, the wave-distance-dividing module is one possible embodiment; however, other embodiments are also

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

disclosed. While the function of distancing light beams may be accomplished by the wave-distance-dividing module, as described in the current application, in addition, the function may also be accomplished by the light-switching module, also as described in the specification, specifically in paragraphs 15 and 42, respectively. Again, this latter description appears to have been overlooked by the Examiner.

Furthermore, even if other embodiments had not been disclosed, the Examiner has not recognized that, assuming, simply for the sake of argument, that some experimentation were called for, this, by itself does not amount to lack of enablement. On the contrary, some amount of experiment may not be unusual in the so-called "predictable" arts. It is reasonable to expect, for example, that one of ordinary skill has sufficient knowledge, in conjunction with the description provided by the current specification, to design and build various component parts that, in combination, may comprise the claimed subject matter of the application, without detailed and laborious plans or blueprints being expressly provided. For example, MPEP 2164.05(a) states:

The state of the prior art provides evidence for the degree of predictability in the art and is related to the amount of direction or guidance needed in the specification as filed to meet the enablement requirement.

Therefore, because, "[t]he level of predictability in the mechanical and electrical arts is recognized as being relatively high," In re Hogan, 559 F.2d 595, 606, 194 USPQ 527, 537-38 (CCPA 1977), as is the case here, a significant amount of detail is not necessary in order for one of ordinary skill to be enabled to make and use the claimed subject matter. Rather, "[t]he fact that some experimentation is necessary does not preclude enablement as long as the amount of experimentation is reasonable given the nature of the invention and the state of the art." In re Wands, 858 F.2d 731, 737 (Fed.Cir.1988). Here, the guidance and direction provided is believed to be more than sufficient to meet this legal standard of enablement.

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

In light of the above remarks taken as a whole, Assignee respectfully requests that the Examiner withdraw the rejection to claims 1-11 on this ground. Likewise, if the Examiner prefers, Assignee is willing to provide an affidavit of one of ordinary skill in the art substantiating it is within his or her level of skill to make and use the claimed subject matter based the direction and guidance provided in the specification without undue experimentation.

Claim Rejections – 35 U.S.C. §112 ¶ 2

In the office action, the Examiner rejected claim 11 under 35 U.S.C. §112 ¶ 2 for being indefinite. The Examiner pointed to the element “the micro-adjusting module” as lacking antecedent basis. Assignee has amended claim 11 to address the Examiner’s request and now asks that the Examiner withdraw the rejection on this basis. Additionally, this amendment is not intended to narrow claim scope and, therefore, no prosecution history estoppel should result.

Claim Rejections – 35 U.S.C. §102(e)

In the office action, the Examiner rejected claims 1-7 of the current application under 35 U.S.C. §102(e) as being anticipated by Kosoburd. Assignee respectfully traverses the Examiner’s rejections for at least the reasons explained herein and respectfully requests that the Examiner withdraw the rejection of these claims on this ground.

We begin with claim 1. Based on Assignee’s review of the applied patent, Kosoburd does not expressly disclose “a light-switching module, for selecting at least one final light source according to the optical storage medium and projecting at least one light beam from the at least one final light source outward.” Likewise, the Examiner appears to agree with this conclusion, because he, instead, asserts that this element is present inherently, rather than expressly.

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

However, Assignee respectfully disagrees with the Examiner's contention that this element is present in Kosoburd inherently. As is well-settled law, in order to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present and that this fact would be so recognized by persons of ordinary skill. Inherency, therefore, may not be established by probabilities or possibilities. For example, it is well-established that the mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *See also* MPEP § 2163.07(a).

In the present case, the Examiner has not established any basis for asserting inherency of the element at issue. Specifically, the Examiner has not established that the missing descriptive matter is necessarily present in the Kosoburd or that this would be recognized by one of ordinary skill. The Federal Circuit has recently stated that to establish inherent anticipation it must be shown that "the disclosure [of the cited document] is sufficient to show that the natural result flowing from the operation as taught [in the cited document] would result in the claimed [subject matter]." SmithKline Beecham Corp. v. Apotex Corp., 403 F.3d 1331, 1343 (Fed. Cir. 2005). Here, however, the Examiner has not attempted to show that the natural result from the operation of the disclosure in Kosoburd would result in Assignee's claimed subject matter and Assignee is unable to reach such a conclusion from a review of Kosoburd. Accordingly, Assignee respectfully asserts that this rejection of claim has been traversed and it is respectfully requested that this rejection of claim 1 on this ground be withdrawn.

Assignee respectfully submits that claims 2-7 depend from claim 1 and, therefore, patentably distinguish from Kosoburd on at least the same basis. Thus, Assignee respectfully requests that the Examiner withdraw the rejections to claims 2-7 on this ground as well.

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

Claim Rejections – 35 U.S.C. §103(a)

In the office action, the Examiner rejected claims 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Kosoburd in view of Ju. However, Kosoburd and Ju, whether viewed individually or in combination, do not teach, suggest or disclose all of the limitations of claims 8 and 10.

The Examiner is kindly reminded that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Assignee's disclosure.” *MPEP* § 2143

However, claims 8 and 10 depend from claim 1. Thus, for at least the reasons discussed above, Kosoburd does not disclose “a light-switching module, for selecting at least one final light source according to the optical storage medium and projecting at least one light beam from the at least one final light source outward,” and Ju fails to cure this deficiency. Assignee, therefore, respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 8 and 10. Assignee respectfully requests that the Examiner withdraw the rejection of claims 8 and 10 on this ground

Similarly, in the office action, the Examiner rejected claims 9 and 11 under 35 U.S.C. §103(a) as being unpatentable over Kosoburd in view of Alon. However, again, claims 9 and 11 depend from claim 1. Because Alon also fails to cure the deficiency of Kosoburd, these claims distinguish on at least the same basis as described above. Assignee, therefore, respectfully requests that the Examiner also withdraw the rejection of these claims on this ground

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

New Claims

New claims 12-42 have been added. Support for these claims may be found throughout the original specification. For instance, support can at least be found in paragraphs 15 and 42. Likewise, support can at least be found in paragraphs 8, 10, 29, 30, 41 and 42 and in Figure 8. It is likewise believed that the new claims distinguish over the patents applied by the Examiner with respect to claims 1-11. For instance, it is believed that none of the applied documents, whether viewed individually or in combination, disclose the subject matter of independent claim 12. Similar comments also apply to the other remaining claims. It is therefore requested that the Examiner allow these new claims and let them proceed to issuance.

It is noted that Assignee believes that the claimed subject matter may be patentably distinguished from the applied documents for additional reasons; however, because the foregoing is believed to be sufficient, Assignee has chosen to omit these additional reasons at this time. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions. Rather, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree. Reconsideration of the above-referenced patent application in view of the above amendments and remarks, again, is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Application No.: 10/605,918

Attorney Docket No.: 112.P14282

CONCLUSION

Assignee asserts that claims 1-42 pending in this patent application are in condition for allowance. If the Examiner has any questions, please contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the pending claims is respectfully requested.

Respectfully submitted,

/Michelle C. Craig/

Michelle Craig – name of esignor
Reg. No. 52,776

Dated:

c/o
Berkeley Law and Technology Group, LLC
1700 NW 167th Place, Suite 240
Beaverton, OR 97006